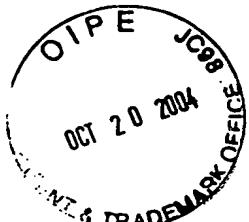


5244-0121-2



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Technology Center 2100

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Tetsuro MOTOYAMA

EXAMINER: EL HADY, N.

SERIAL NO. 09/453,934

FILED: May 17, 2000

GROUP ART UNIT: 2154

FOR: METHOD AND SYSTEM OF REMOTE DIAGNOSTIC, CONTROL AND INFORMATION COLLECTION USING A DYNAMIC LINKED LIBRARY...

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

This is an appeal from the decision of the Examiner dated April 20, 2004, which finally rejected Claims 1-20 in the above-identified patent application.

I. REAL PARTY-IN-INTEREST

Ricoh Company, Ltd.

II. RELATED APPEALS AND INTERFERENCES

Appellants make of record all prior and pending appeals that could directly affect or be directly affected by or have a bearing on the Board's decision in this appeal. They are U.S. Appeal No. 2002-0867 (Board Decision mailed December 23, 2003 attached), U.S. Appeal No. 1999-2767 (Board Decision and attachments mailed September 5, 2002 attached), U.S. Appeal No. 2003-0544 (Board Decision mailed December 30, 2003 attached), U.S. Appeal No. 2003-0218 (Board Decision pending), U.S. Appeal No. 2004-1205 (Board Decision mailed June 18, 2004 attached), U.S. Appeal No. 2002-2316 (Board Decision mailed April

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30, 2003 attached), U.S. Application Serial No. 09/393,677 (Examiner's Answer pending), U.S. Application Serial No. 09/440,692 (Examiner's Answer pending), and U.S. Application Serial No. 09/453,937 (Remanded to Examiner to consider four Information Disclosure Statements). The applications at issue therein name an inventor in common with the present application.

III. STATUS OF CLAIMS

Claims 1-20 are rejected, and Claims 1-20 are being appealed.

IV. STATUS OF AMENDMENTS

All amendments in this application have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed to monitoring an image forming apparatus (e.g., a copying machine or scanner) or an appliance (e.g., a microwave oven or VCR), collecting communicating events at the image forming apparatus or appliance, and communicating the collected events from the image forming apparatus or appliance to a remote receiver. See [p13].¹ In some embodiments, the present invention can include an operation panel on a device application unit, and the invention "can monitor a user selecting controls on such an operation panel." [p79] and see also [p86]-[p87].

¹ This application was filed as part of a PTO pilot program for electronic filing. At the time of the program, paragraphs were numbered as "[pxx]" where "xx" is a sequential paragraph number. Accordingly, it is not possible to refer to page and line numbers as they were assigned after the applicant filed and are unknown to the applicant.

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However, because communications between the device being monitored and the remote receiver may encounter problems, or one may wish to use increased redundancy, the present invention may utilize “plural protocols and/or plural data formats.” [p105]. Protocols include the rules for the data exchange, and, as discussed in the specification in [p107], include, for example, SMTP (Simple Mail Transfer Protocol), FTP (File Transfer Protocol) and HTTP (HyperText Transfer Protocol). “Exemplary formats include, but are not limited to, uncompressed or compressed versions or any one of: un-delimited text, SGML, XML, HTML, csv format, and binary.” [p105]. As claimed, the present invention may be configured to attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first protocol or format and then attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second protocol or format after attempting to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first protocol or format. However, the claims recite protocols and formats separately.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The four issues on appeal are (1) whether claim 18 is anticipated under 35 U.S.C. § 102(e) in light of U.S. Patent No. 6,487,581 (hereinafter “the ‘581 patent”), (2) whether claims 1-7 are anticipated or obvious under 35 U.S.C. §§ 102(e)/103 in light of U.S. Patent No. 6,539,422 (hereinafter “the ‘422 patent”), either alone or in combination with at least one

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other reference, (3) whether claims 19 and 20 are anticipated under 35 U.S.C. § 102(e) in light of the '581 patent, and (4) whether claims 8-17 are anticipated or obvious under 35 U.S.C. §§ 102(e)/103 in light of the '422 patent, either alone or in combination with at least one other reference.

VII. ARGUMENTS

A. Rejection of claim 18

Claim 18 recites:

performing a first attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first protocol; and

performing a second attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second protocol after the first attempt.

The Office Action cites the '581 patent as anticipating all of the elements of claim 18, including the two elements listed above. However, neither of the two cited sections of the '581 patent disclose performing first and second attempts using first and second protocols.

The '581 patent discloses that "The Event Server can interact with web clients, including a Java applet, and other types of clients including a universal viewer/browser of NNM described in the copending U.S. Application referred to above." Col. 4, lines 32-36. However, the fact that multiple applications can receive the same data does not indicate that the protocols used between those applications are different. The same protocol could be used

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for all the applications that are supported, thus reducing the complexity of the disclosed system.

Moreover, claim 18 recites that the first and second protocol are used to transfer events collected from the location at which both protocols are being used. From the sections of the '581 patent cited by the Office Action, it appears that the Event Server collects events from remote sites, and the Office Action has not asserted that those remote sites attempt to transmit in more than one protocol.

The Office Action further cites that "other client applications can be created to interface with the Event Server." Col. 5, lines 20-22. Again, as discussed above, the Office Action has not proven that the "other applications" would have utilized different protocols than the disclosed web-based protocol. It should be noted that col. 5, lines 36-49, discloses utilizing a number of incoming ports, but despite such a disclosure, there is no evidence cited that shows that first and second protocols would be used to attempt to transfer the collected events.

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B. Rejection of claims 1-7

Claim 1 recites “a sixth computer code device configured to attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second protocol after attempting to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first protocol.” Thus, two attempts to transfer the collected events using two different formats have to be made to anticipate this limitation.

In the outstanding rejection, the office action cites the '422 patent, col. 20, lines 17-37, as teaching this limitation. However, that section does not appear to relate to the claimed subject matter and instead states:

The ADC data server 510 supports an SNMP ADC group MIB in cooperation with the ADC devices such as the ADC devices 101 and 102. A Reader Group MIB provides ADC device configuration, reporting ADC device statistics and running end device diagnostics. MIB subgroups support the Reader Group MIB for each end device and for the ADC data server itself.

FIG. 14 provides additional detail for the SNMP master agent 220 and the SNMP subagents. The ADC device platform SNMP architecture uses a master/sub agent concept. The SNMP master agent 220 receives incoming SNMP requests and routes them to the appropriate SNMP subagents for processing. The SNMP subagents respond to the SNMP master agent 220 which in turn formats the SNMP response. According to one embodiment of the invention, the ADC device platform 100 has SNMP subagents for: barcode reader configuration; control, diagnostic and statistics; system management; UDP+; 802.11 MIB, and WindowsCE. Each of these SNMP

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subagents communicates with a ADC device platform 100 subsystem in order to satisfy most SNMP requests.

In no part of the cited sections does the '422 patent describe a single computer program product using more than one protocol to transfer the collected events. In fact, the Office Action cites to the same section of the '422 patent for the first and second protocols, and does not show how more than one protocol is used. Also, since at most one protocol is disclosed as being used by any computer code device, one of the second and third computer code devices must also not be disclosed by the '422 patent.

Moreover, if the Office Action is intending to assert that the SNMP System Management Support Unit 210 utilizes two protocols, it has not shown that the unit 210 attempts to transfer collected events using two protocols. Claim 1 does not recite receiving in one protocol and transmitting in a second; it recites attempting to transmit collected events in two protocols.

In addition, the Office Action's citation to the abstract of the '422 patent does not cure the above-noted deficiencies. The types of documents listed are not indicated as being event information or documents containing the collected event information. They could simply be different information in different formats, e.g., web interfaces for controlling how statistics are collected and other control information.

Furthermore, the abstract, also cited by the Office Action, appears to verify the above arguments that the '422 patent simply receives data formatted in one way and transmits it as data in another format. The reverse translation between formats is later performed for different data.

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In summary, the Office Action has failed to show that the sixth computer code device and one of the second and third computer code devices are anticipated by the '422 patent. Moreover, none of the other references cited by the Office Action make up for the above-noted deficiency of the '422 patent with respect to the dependent claims. Thus, claims 1-7 are patentable over the applied reference(s).

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C. Rejection of claims 19 and 20

As discussed above with respect to claim 18, the Office Action has failed to show that the '581 patent discloses using first and second protocols. Claim 19 is rejected for the same reason as claim 18, thus it would be patentable over the '581 patent if it too recited first and second protocols. However, claim 19 recites using first and second formats. The Office Action does not appear to have even alleged that the '581 patent utilizes first and second formats. Even if it did allege so, the same sections of the '581 patent that failed to show attempting to transmit using first and second protocols also fail to show attempting to transmit using first and second formats. Thus, claim 19 and its dependent claim 20 are patentable over the '581 patent.

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D. Rejection of claims 8-17

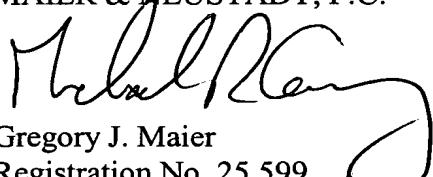
As discussed above with respect to claim 1, the Office Action has failed to show that the '422 patent discloses using first and second protocols. Claim 8 is rejected for the same reason as claim 1, thus it would be patentable over the '422 patent if it too recited first and second protocols. However, claim 8 recites using first and second formats. The Office Action does not appear to have even alleged that the '422 patent utilizes first and second formats. Even if it did allege so, the same sections of the '422 patent that failed to show attempting to transmit using first and second protocols also fail to show attempting to transmit using first and second formats. Moreover, none of the other references cited by the Office Action make up for the above-noted deficiency of the '422 patent with respect to the dependent claims. Thus, claim 8 and its dependent claims 9-17 are patentable over the '422 patent.

Conclusion

It is respectfully requested that the outstanding rejections be REVERSED.

Respectfully submitted,

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CLAIMS APPENDIX: APPEALED CLAIMS 1-20

Claim 1. A computer program product, comprising:

a computer storage medium and a computer program code mechanism embedded in the computer storage medium for causing a computer to control a protocol used for data communication between a remote receiver and at least one of a device, an appliance, an application and an application unit, the computer program code mechanism comprising:

 a first computer code device configured to provide plural communications protocols capable of providing data transfer;

 a second computer code device configured to select a first protocol of the plural communications protocols to transfer data between the remote receiver and the at least one of a device, an appliance, an application and an application unit;

 a third computer code device configured to select a second protocol of the plural communications protocols to transfer data between the remote receiver and the at least one of a device, an appliance, an application and an application unit;

 a fourth computer code device configured to collect events at the at least one of a device, an appliance, an application and an application unit;

 a fifth computer code device configured to attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first protocol; and

 a sixth computer code device configured to attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second protocol after attempting to transfer the

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collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first protocol.

Claim 2. The computer program product as claimed in claim 1
wherein the first computer code device comprises a library of code shared between first and second applications.

Claim 3. The computer program product as claimed in claim 1,
wherein the first computer code device comprises a dynamically linked library of code shared between first and second applications.

Claim 4. The computer program product as claimed in claim 1,
wherein the plural communications protocols comprise at least one of (1) a store and forward protocol and (2) a direct connection protocol.

Claim 5. The computer program product as claimed in claim 1,
wherein the plural communications protocols comprise (1) a simple mail transfer protocol and (2) at least one of (a) a file transfer protocol and (b) a hypertext transfer protocol.

Claim 6. The computer program product as claimed in claim 1,
wherein the sixth computer device comprises a seventh computer code device

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configured to check for a transmission failure before transferring the collected events using the second protocol.

Claim 7. The computer program product as claimed in claim 1,
wherein the sixth computer device comprises a seventh computer code device
configured to transfer the collected events using the second protocol in order to increase
redundancy.

Claim 8. A computer program product, comprising:
a computer storage medium and a computer program code mechanism embedded in
the computer storage medium for causing a computer to control a data format used for data
communication between a remote receiver and at least one of a device, an appliance, an
application and an application unit, the computer program code mechanism comprising:
a first computer code device configured to provide plural communications
formats capable of providing data transfer;
a second computer code device configured to select a first format of the plural
communications formats to transfer data between the remote receiver and the at least one of a
device, an appliance, an application and an application unit;
a third computer code device configured to select a second format of the plural
communications formats to transfer data between the remote receiver and the at least one of a
device, an appliance, an application and an application unit;
a fourth computer code device configured to collect events at the at least one

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of a device, an appliance, an application and an application unit;

a fifth computer code device configured to attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first format; and

a sixth computer code device configured to attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second format after attempting to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first format.

Claim 9. The computer program product as claimed in claim 8,
wherein the first computer code device comprises a library of code shared between first and second applications.

Claim 10. The computer program product as claimed in claim 8,
wherein the first computer code device comprises a dynamically linked library of code shared between first and second applications.

Claim 11. The computer program product as claimed in claim 8,
wherein the plural communications formats comprise at least two formats selected from the group consisting of: binary, text, hypertext markup language (HTML), and extended markup language (XML).

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Claim 12. The computer program product as claimed in claim 8,
wherein at least one of the plural communications formats comprises a compressed
format.

Claim 13. The computer program product as claimed in claim 8,
wherein the sixth computer device comprises a seventh computer code device
configured to check for a transmission failure before transferring the collected events using
the second format.

Claim 14. The computer program product as claimed in claim 8,
wherein the sixth computer device comprises a seventh computer code device
configured to transfer the collected events using the second format in order to increase
redundancy.

Claim 15. The computer program product as claimed in claim 8, further comprising:
a seventh computer code device configured to provide plural communications
protocols capable of providing data transfer; and
an eighth computer code device configured to select a first protocol of the plural
communications protocols to transfer data between the remote receiver and the at least one of
a device, an appliance, an application and an application unit,
wherein the fifth computer code device is further configured to transfer the collected

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events with the first protocol using the first format.

Claim 16. The computer program product as claimed in claim 8, further comprising:
a seventh computer code device configured to provide plural communications
protocols capable of providing data transfer; and
an eighth computer code device configured to select a first protocol of the plural
communications protocols to transfer data between the remote receiver and the at least one of
a device, an appliance, an application and an application unit,
wherein the sixth computer code device is further configured to transfer the collected
events with the first protocol using the second format.

Claim 17. The computer program product as claimed in claim 8, further comprising:
a seventh computer code device configured to provide plural communications
protocols capable of providing data transfer; and
an eighth computer code device configured to select a first protocol of the plural
communications protocols to transfer data between the remote receiver and the at least one of
a device, an appliance, an application and an application unit,
wherein the fifth computer code device is further configured to transfer the collected
events with the first protocol using the first format;
a ninth computer code device configured to select a second protocol of the plural
communications protocols to transfer data between the remote receiver and the at least one of
a device, an appliance, an application and an application unit,

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wherein the sixth computer code device is further configured to transfer the collected events with the second protocol using the second format.

Claim 18. A computer computer-implemented method for causing a computer to control a protocol used for data communication to a remote receiver, comprising:

providing plural communications protocols capable of transferring data;

selecting a first protocol of the plural communications protocols to transfer data between the remote receiver and at least one of a device, an appliance, an application and an application unit;

selecting a second protocol of the plural communications protocols to transfer data between the remote receiver and the at least one of a device, an appliance, an application and an application unit;

collecting events at the at least one of a device, an appliance, an application and an application unit;

performing a first attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first protocol; and

performing a second attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second protocol after the first attempt

Claim 19. A computer computer-implemented method for causing a computer to

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control a format used for data communication to a remote receiver, comprising:

 providing plural communications formats capable of providing data transfer;

 selecting a first format of the plural communications formats to transfer data between the remote receiver and at least one of a device, an appliance, an application and an application unit;

 selecting a second format of the plural communications formats to transfer data between the remote receiver and the at least one of a device, an appliance, an application and an application unit;

 collecting events at the at least one of a device, an appliance, an application and an application unit;

 performing a first attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first format; and

 performing a second attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second format after the first attempt.

Claim 20. The computer computer-implemented method as claimed in claim 19, wherein the step of performing a first attempt to transfer the collected events comprises performing an attempt using a first protocol.

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RELATED PROCEEDINGS APPENDIX

OCT 20 2004

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 57

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TETSURO MOTOYAMA

Appeal No. 2002-0867
Application No. 08/738,659

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OCT 25 2004

Technology Center 2100

HEARD: October 21, 2003

Before BARRETT, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 10, 12-19, 36, 38-44, 52-61, and 68-87, which are all the claims remaining in the application.

We affirm-in-part, and enter a new ground of rejection in accordance with 37 CFR § 1.196(b).

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BACKGROUND

The invention is directed to a method and system for communications, using electronic mail, between a monitoring device and a device monitored by the monitoring device. Claim 10 is reproduced below.

10. A method for communicating between a monitored device and a monitoring device, comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device; and

transmitting the information through electronic mail from the monitoring device to the monitored device.

The examiner relies on the following references:

Banno et al. (Banno)	4,876,606	Oct. 24, 1989
Kraslavsky et al. (Kraslavsky)	5,537,626	Jul. 16, 1996 (filed Feb. 13, 1995)
Cohn et al. (Cohn)	5,740,231	Apr. 14, 1998 (filed Sep. 16, 1994)

Claims 10, 12-19, 36, 38-44, 52-61, and 68-87 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Kraslavsky and Cohn.¹

We refer to the Rejection (Paper No. 41; mailed Jul. 30, 2001) and the Examiner's Answer (Paper No. 47; mailed Nov. 19, 2001) for a statement of the

¹ Banno, relied upon as showing an inherent feature of Kraslavsky, should have been included in the initial statement of the rejection as to the relevant claims. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection.").

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examiner's position and to the Brief (Paper No. 45; filed Aug. 29, 2001) and the Reply Brief (Paper No. 48; filed Jan. 14, 2002) for appellant's position with respect to the claims which stand rejected.²

OPINION

Section 103 rejection of claims 10, 12-19, 36, 38-44, 52-61, and 68-87 over Kraslavsky and Cohn

The statement of the rejection of claims 10, 12-19, 36, 38-44, 52-61, and 68-87 under 35 U.S.C. § 103 as being unpatentable over Kraslavsky and Cohn is set forth in the Answer. Since Kraslavsky is deemed to not explicitly teach that messages are transmitted as Internet electronic mail messages, the rejection adds Cohn to show suggestion to use an Internet electronic mail message format. (Answer at 5.)

A. Claims 10, 16, 36, 42, 74, 78, 82, and 86

Instant claims 10, 16, 36, 42, 74, 78, 82, and 86 do not require transmission of Internet messages, nor sending messages in an Internet format. We enter new

² The file contains a paper styled as a "Final Rejection," purportedly "Paper No. 46," which further purports to be in response to appellant's paper filed August 29, 2001 (i.e., the Brief). The final page of said Paper No. 46 contains a printed date of December 30, 2001. However, the paper is not stamped with a mailing date; it is thus unclear whether a copy of the paper was mailed to appellant. Moreover, the paper does not appear to withdraw the earlier rejection and reopen prosecution. Further, another "Paper No. 46," mailed November 19, 2001, documents consideration of an Information Disclosure Statement submitted by appellant. In any event, the appeal is from the rejection mailed July 30, 2001. We have jurisdiction because the claims have been twice rejected as of the date of the rejection under appeal.

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grounds of rejection against these claims, infra. Since Kraslavsky discloses all that is required by the claims, we will sustain the rejection of these claims under 35 U.S.C. § 103.

B. Claims 12-15, 17-19, 38-41, 43, 44, 52-61, 68-73, 75-77, 79-81, 83-85,

and 87

The remainder of the claims require, as set forth in broadest claims 54, 68, 69, 70, and 71 of the group, transmitting an Internet electronic mail message over the Internet, or outside of a local network. We interpret transmission of the Internet electronic mail message, as claimed, as requiring more than the electronic message transmission as disclosed by Kraslavsky. We note, in particular, appellant's description of Internet mail communications at page 7 of the specification.

In response to the section 103 rejection over Kraslavsky and Cohn, appellant argues, inter alia, that at the time of invention email (or Internet electronic mail transmission, as required by the instant group of claims), was considered to lack interactivity and rapid communication features. Appellant relies on an expert's declaration (submitted May 11, 2001) as support for the view. Appellant posits that, as a consequence, the artisan would not have thought to modify the Kraslavsky system.
(Brief at 8-9.)

We are substantially in agreement with the examiner's position (e.g., Answer at 11-12). Neither the briefs nor the declaration point to any express support for the

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position in the references. Neither the briefs nor the declaration rely on any other factual support tending to substantiate appellant's position.

However, we agree with appellant, as developed in the briefs and the declaration, that the combination of Kraslavsky and Cohn would not have suggested transmission of Internet electronic communications between a monitored and a monitored device as claimed. We disagree with appellant to the extent that appellant may hold that neither reference discloses use of the Internet (e.g. declaration at 10). Cohn teaches a message format having an "Internet style address" (col. 15, l. 65 - col. 16, l. 36) that facilitates communications with messaging systems such as Internet service providers (col. 15, ll. 21-32).

However, as pointed out at page 6, paragraph 11 of the declaration, all of the messages contemplated by Cohn originate from a human and are intended for a human recipient. Kraslavsky deals with device status monitoring on a LAN or on one or more LANs in a wide-area network (WAN), as described at column 7, line 38 et seq. of the reference. We find no disclosure or suggestion in Kraslavsky or Cohn, nor in any combination of teachings thereof, for transmitting Internet electronic mail messages between machines, for monitoring devices, as claimed by appellant. The Banno reference, applied by the examiner to show an asserted inherent feature of Kraslavsky, fails to remedy the deficiency of Kraslavsky and Cohn.

We thus do not sustain the Section 103 rejection of claims 12-15, 17-19, 38-41, 43, 44, 52-61, 68-73, 75-77, 79-81, 83-85, and 87.

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New Ground of Rejection -- 37 CFR § 1.196(b)

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 1.196(b): Claims 10, 16, 36, 42, 74, 78, 82, and 86 are rejected under 35 U.S.C. § 102(e)(2) as being anticipated by Kraslavsky.

Independent claims 10, 16, 36, and 42 recite transmitting information through "electronic mail." The instant specification does not set forth any particular definition for the term. We are thus faced with the problem of determining the metes and bounds of the recitation; a problem that we addressed in a decision in an earlier appeal in a related application. In particular, in that application (S.N. 08/738,461; Appeal No. 1999-2767), we determined that the term is broad in scope. We reproduce below the pertinent section from the earlier decision, which applied the claimed "electronic mail message" to the Kraslavsky reference.

A section 103 analysis begins with a key legal question – what is the invention claimed? Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). At the oral hearing, appellant's counsel confirmed that Kraslavsky discloses a process that meets all requirements of instant claim 88, with one exception argued by appellant – although the reference discloses receiving and analyzing electronic messages, the messages are not deemed to be electronic "mail" messages. Determining the metes and bounds of the recitation "electronic mail message" is thus a material inquiry in proper interpretation of claim 88.

Counsel for appellant conceded that the instant specification does not provide a definition for the relevant term. However, counsel submitted that the term is well-known in the art, and that a formal definition may be found by reference to technical dictionaries.

The McGraw-Hill Dictionary of Scientific and Technical Terms, (5th ed. 1994), at page 663, defines electronic mail as "[t]he electronic transmission of letters, messages, and memos through a communications

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network." The New IEEE Standard Dictionary of Electrical and Electronics Terms (5th ed. 1993), at page 426, defines electronic mail as "[t]he generation, transmission, and display of correspondence and documents by electronic means." The Microsoft Press Computer Dictionary (2nd ed. 1994), at page 143, defines electronic mail as "[t]he transmission of messages over a communications network." [Footnote omitted.] The Microsoft Press dictionary entry for the relevant term goes on to describe ways in which electronic mail may be used, but does not restrict "electronic mail" to any particular format or protocol, nor to any particular communications network equipment.

We acknowledge that there may be other definitions in other technical dictionaries suggesting a narrower meaning for "electronic mail" than those definitions we have noted. However, that narrower definitions might be found is immaterial in the present inquiry. Claims are to be given their broadest reasonable interpretation during prosecution. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." Zletz, 893 F.2d at 321, 13 USPQ2d at 1322.

In view of the above-noted technical dictionary definitions, we fail to see how the broadest reasonable interpretation of "electronic mail message" as presented in instant claim 88 precludes the electronic communication of files over the local area network (LAN) disclosed by Kraslavsky.

Appellant's specification (at 9-10) provides a formal definition of "connectionless-mode transmission," and suggests that Internet electronic mail systems may provide a means for connectionless-mode of communication (at 18). However, the artisan knew that communication across a LAN as disclosed by Kraslavsky is also a form of connectionless-mode transmission. At the hardware level, each EtherNet board on the LAN has a unique Media Access Control (MAC) address. Col. 9, ll. 25-34. Data are transferred in frame packets comprised of the destination address, the source address, and a data section. Col. 28, ll. 23-35; Fig. 9. There is no direct connection between a source and destination of data transferred on the network.

In Kraslavsky, by means of PC 14 the network administrator may perform extensive monitoring of printer 4. Col. 6, l. 45 - col. 7, l. 19. However, Kraslavsky discloses that any PC on the network (Figure 1) may

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request the status – i.e., monitor – and utilize the services of printer 4 via the network and the network expansion board (NEB) 2 within printer 4. Further, printer 4 analyzes a received print job and prints the received data accordingly. Col. 8, l. 24 - col. 9, l. 4.

We find that printer 4 receiving, analyzing, and printing a text document from a PC on the network meets all the requirements of instant claim 88.

At the oral hearing, counsel for appellant also offered an informal definition of "electronic mail message," along the lines that such a message requires a subject line and is intended as communication between human beings. However, the technical dictionary definitions of the relevant term do not require so narrow an interpretation. Moreover, as disclosed and claimed, the "electronic mail message" is intended for machine processing -- counsel emphasized that when read in light of the specification, claim 88 requires that a machine, rather than a human being, analyze the electronic mail message. The requirements of claim 88 are thus contrary to an informal or functional definition of "electronic mail message" that requires that the message be intended for, or readable by, human beings.³

Since we find all requirements of claim 88 met within the four corners of the Kraslavsky reference, we consider Cohn to be merely cumulative in the section 103 rejection. We also refer to the Kraslavsky reference alone for the requirements that the electronic mail message is received through a LAN (claim 108/88) and without using a telephone line (claim 109/108/88). We thus find the subject matter of all representative claims to be anticipated by Kraslavsky.

We sustain the rejection of claims 88-139 under 35 U.S.C. § 103. A finding of anticipation means that the claims are also obvious under 35 U.S.C. § 103; anticipation is the epitome of obviousness. See, e.g., Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193,

³ Although not shown in the prior art before us, counsel was also asked what language in claim 88 might be thought to distinguish over a computer workstation causing an icon (e.g., an envelope icon) to appear on the computer display screen to notify one that an e-mail (intended for a human being) has been received. Counsel argued that a computer display screen (e.g., a CRT) would not be considered a "business office device," referring to the paragraph bridging pages 14 and 15 of the specification. However: (1) appellant's list of "business office machines" is clearly illustrative, rather than exhaustive; and (2) a computer display screen is not a "general purpose computer." Moreover, it is far from apparent why a printer can be considered a "business office device" but a computer display screen cannot. Business-related text or graphics is often viewed on a display before printing.

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Evidence of secondary considerations such as "long-felt but unresolved need" is irrelevant when the invention lacks novelty. See, e.g., In re Malagari, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974) (citing In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973)). Moreover, evidence submitted to show nonobviousness is not relevant or material when an invention is anticipated. We thus will not consider or further address appellant's reliance (e.g., Brief at 5) on declarations submitted to show nonobviousness of the invention.

In the instant case, claim 10 recites a method for communicating between a monitored device and a monitoring device, comprising determining information to be transmitted by the monitoring device to the monitored device, the information including a request for status of the monitored device determined using sensors within the monitored device.

Kraslavsky discloses a printer 4 (Fig. 1) on a local area network (LAN) 6. The printer includes a network expansion board (NEB) interfacing the printer to the LAN. The network may use network software, such as Unix software, to effect communication over the various network members. Col. 4, ll. 1-58. With use of the NEB, "verbose amounts" of status information may be provided from the printer 4 to the LAN, including more than the simple "out of paper" and "off line" status messages that prior systems allowed. Col. 6, ll. 18-62.

Software on the network administrator's PC 14 allows request of status information from the printer. Col. 14, ll. 27-48. Software at the remote printer outputs

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the device status information in response. Col. 18, ll. 34-59. The communications may use TCP/IP protocol, if the LAN is running a Unix operating system. Col. 18, l. 60 - col. 19, l. 4. As shown in Figure 5C, the network administrator may request detailed status information from the printer (or other peripheral device on the network, if equipped with an NEB), the status information being transmitted from the printer through the LAN to the administrator's PC 14. Col. 20, l. 49 - col. 21, l. 15.

Kraslavsky thus discloses a monitoring device (PC 14) which determines information to be transmitted to a monitored device (printer 4), the information including a request for status of the printer determined using sensors within the printer, such as sensors that ascertain if the printer is off-line or out of paper.

Claim 10 further requires that the information from the monitoring device to the monitored device (e.g., the request for status) be transmitted through "electronic mail." In view of the broadest reasonable interpretation of "electronic mail," as we discussed in the above-noted prior decision -- "electronic mail" requires "the transmission of messages over a communications network" -- we find no difference between the relevant claim 10 requirement and the transmission of the PC 14 message to printer 4, over the LAN 6 using TCP/IP protocol within a Unix operating system, as disclosed by Kraslavsky.

Instant claim 74, depending from claim 10, requires that the transmitting step comprises transmitting the electronic mail message "without using a telephone line."

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Kraslavsky, disclosing transmission of the message over a LAN, is squarely within the terms of the negative limitation of claim 74.

We have addressed the substantive limitations of independent claim 10 and dependent claim 74. The remainder of the claims (16, 36, 42, 78, 82, and 86) are also anticipated, reciting limitations similar in scope to claims 10 and 74.

Declaration submitted at oral hearing

In anticipation that we might enter new grounds of rejection over Kraslavsky, based on a broader interpretation of "electronic mail," as we did in the earlier appeal, appellant's representative presented copies of an expert's declaration (37 CFR § 1.132) at the oral hearing.⁴ The declarant states therein (¶ 9) that "[i]t is my understanding that the meaning of electronic mail may be at issue."

The declarant sets forth the opinion (¶ 12) that the artisan would have considered, at the time of invention, the basic features of electronic mail to be that (1) electronic mail is used to send messages between electronic devices, (2) electronic mail is sent through or received from an electronic mail box or e-mail account, and (3) electronic mail is sent through or received from a host computer, sometimes referred to as a "mail server."

⁴ A copy of the declaration has been entered in the instant file wrapper as Paper No. 56.

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As factual support for the opinion, the declaration provides, and references, a portion (six pages) of a text published in 1995. As set forth on the second page of the provided copies, the text, "At ease with e-mail: A handbook on using electronic mail for NGOs in developing countries," prepared by the United Nations Non-Governmental Liaison Service and the Friedrich Ebert Foundation (New York Office), is "for beginners." Our review of the reference confirms that the text is directed to end users of electronic communications systems, rather than to designers of the systems. The reference thus has little relevance in showing the artisan's understanding of the relevant term.

We acknowledge that the most common conception of electronic mail may have required the three features set forth in the declaration, even with respect to one skilled in the art. The most common definition of "electronic mail" is not at issue. Rather, the inquiry is with respect to the metes and bounds of the subject matter that may be included within the scope of the term, under the broadest reasonable interpretation as understood by the artisan at the time of invention.

The declaration also refers to the instant disclosure, at page 15, which relates registering the name and address of the monitored device in a mail server, "for example," which will send and receive electronic mail for the network to which the mail server is connected. The claims that we reject as anticipated by Kraslavsky, however, say nothing about a mail server, nor about using a mail server.

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Our evaluation of the declaration does not convince us that the broadest reasonable interpretation of "electronic mail" requires an interpretation that excludes the electronic communications described by Kraslavsky. While the expert's declaration provides evidence entitled to our careful consideration, the declaration does not attempt to harmonize -- nor does it even address -- the evidence that supports a more expansive definition for the term; e.g., the technical dictionary definitions we have previously noted.

Naugle

U.S. Patent 5,715,393 ("Naugle,") filed Jun. 21, 1995, issued Feb. 3, 1998, has been cited as a reference by appellant during prosecution of the instant application. (See Paper No. 39; filed May 23, 2001.) We will not take the filing of the IDS as an unrefutable admission that Naugle is prior art with respect to appellant. However, in the event of further prosecution, appellant should clarify the status of Naugle with respect to this application.

Moreover, although Naugle is not a reference under 35 U.S.C. § 102, we note that the patent is a continuation-in-part of an application filed August 16, 1993, prior to appellant's claimed priority date of June 5, 1995. The earlier-filed application (106,733), according to USPTO records, was abandoned as part of a file-wrapper-continuation of the application that matured into the Naugle patent.

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For reasons set forth in In re Wertheim, 646 F.2d 527, 531-39, 209 USPQ 554, 559-66 (CCPA 1981), when a patent disclosure relies on one or more continuation-in-part applications in a chain of priority under 35 U.S.C. § 120, there must be a determination with respect to what effect the presentation of new matter has in the patent's chain of priority -- whether the patent disclosure represents "secret prior art" as to the application at issue, and thus whether or not effective as a reference.

If...[the USPTO] wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

Wertheim, 646 F.2d at 537, 209 USPQ at 564.

The determinative question is whether the invention claimed in Naugle finds a supporting disclosure, in the earlier-filed application in question, in compliance with section 112, as required by section 120, so as to entitle that invention as "prior art" to the filing date of the patent's earlier-filed application. See id. The only date a patent has under section 102(e)(2) is the filing date of the application on which the patent issued. "Any earlier U.S. filing date for the patent necessarily depends on further compliance with §§ 120 and 112." Wertheim, 646 F.2d at 538, 209 USPQ at 565.

Naugle, if considered a reference, would appear to be material to patentability of instant claims 10, 16, 36, 42, 74, 78, 82, and 86. For that reason, if the examiner has not done so, the examiner should inspect the file wrapper of the Naugle patent and

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determine if the earlier-filed application contains §§ 120/112 support for the invention claimed in the patent.⁵

The Naugle patent describes a method for communicating between a monitored device and a monitoring device, comprising the steps set forth by instant (representative) claim 10.

Naugle describes, at column 2 of the reference, computers connected in a network 37 (Fig. 1) using TCP/IP network protocol. At a predetermined time monitor computer 11 sends a network verify command to a target computer 12 (Fig. 2). Next, a test of the email capability of the target computer is performed to ensure that email service in the target computer is operational. Col. 3, ll. 7-10. Naugle describes using the "Sendmail" software package, which is standard in the "Unix-like" operating systems of the respective computers. Id. at ll. 21-30.

Naugle further describes that, after the monitoring device (monitor computer 11) receives an email reply message from the monitored device (target computer 12), the monitor computer determines information to be sent via an email message to the target computer. The monitor computer sends a message requesting status information (col. 4, ll. 9-35), and the target computer transmits to the monitor computer a message containing the requested status information (col. 5, ll. 22-26). Status of the target

⁵ If rejection over Naugle is indicated, to make a *prima facie* case for unpatentability -- without relying on an admission by appellant that Naugle is prior art -- any statement of rejection must include findings with respect to how the earlier-filed application contains §§ 120/112 support for the invention claimed in Naugle.

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computer may be determined using sensors within the target -- e.g., sensors determining disk space availability in the target (entries in table bridging cols. 3, 4 and 4, 5, and text at col. 5, ll. 35-42).

CONCLUSION

We have sustained the rejection of claims 10, 16, 36, 42, 74, 78, 82, and 86 under 35 U.S.C. § 103, but have not sustained the rejection of claims 12-15, 17-19, 38-41, 43, 44, 52-61, 68-73, 75-77, 79-81, 83-85, and 87. The examiner's decision in rejecting claims 10, 12-19, 36, 38-44, 52-61, and 68-87 is thus affirmed-in-part.

Claims 10, 16, 36, 42, 74, 78, 82, and 86 are newly rejected by us under 35 U.S.C. § 102.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claim:

(1) Submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 2002-0867
Application No. 08/738,659

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART -- 37 CFR 1.196(b)

Lee E. Barrett

LEE E. BARRETT
Administrative Patent Judge

Stuart S. Levy
STUART S. LEVY
Administrative Patent Judge

Howard B. Blankenship
HOWARD B. BLANKENSHIP
Administrative Patent Judge

)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

Appeal No. 2002-0867
Application No. 08/738,659

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA , VA 22314



5244-0052-2x2

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 51

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte TETSURO MOTOYAMA

SEP 05 2002

Appeal No. 1999-2767
Application No. 08/738,461

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

HEARD: August 15, 2002

Before BARRETT, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

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DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 88-139, which are all the claims remaining in the application.

We affirm.

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OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.

DOCKETING DEPT.

Initials/Date Docketed: 10/19/02
Type of Resp(s): Req Rehearing / Appeal to CAFC
Due Date(s): 11-5-02 (Non - Ext)

Appeal No. 1999-2767
Application No. 08/738,461

BACKGROUND

The invention is directed to a method and system for monitoring, controlling, and diagnosing operation of a business office machine. Representative claim 88 is reproduced below.

88. A method for communicating, comprising the steps of:
receiving an electronic mail message from a monitoring device;
analyzing the electronic mail message; and
performing an action by a business office device for at least one of monitoring, controlling, and diagnosing the business office device, in response to the electronic mail message, after the electronic mail message is analyzed.

The examiner relies on the following references:

Kraslavsky et al. (Kraslavsky)	5,537,626	Jul. 16, 1996 (filed Feb. 13, 1995)
Cohn et al. (Cohn)	5,740,231	Apr. 14, 1998 (filed Sep. 16, 1994)

Claims 88-139 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kraslavsky and Cohn.

We refer to the Rejection (mailed Jul. 27, 2001) and the Examiner's Answer (mailed Dec. 28, 2001) for a statement of the examiner's position and to the Brief (filed Aug. 29, 2001) and the Reply Brief (filed Feb. 25, 2002) for appellant's position with respect to the claims which stand rejected.

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OPINION

Grouping of Claims

Appellant asserts there are two separate groups of claims (Brief at 4). We select claim 88 as representative of Group I. See 37 CFR § 1.192(c)(7). However, since appellant refers, in the argument section of the Brief (at 12), to requirements arising from limitations in separate claims within Group II, we select claims 108/88 (108 depending from 88) and 109/108/88 (109 depending from 108/88) as representative of the claims of Group II.

The rejection

A section 103 analysis begins with a key legal question -- what is the invention claimed? Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). At the oral hearing, appellant's counsel confirmed that Kraslavsky discloses a process that meets all requirements of instant claim 88, with one exception argued by appellant -- although the reference discloses receiving and analyzing electronic messages, the messages are not deemed to be electronic "mail" messages. Determining the metes and bounds of the recitation "electronic mail message" is thus a material inquiry in proper interpretation of claim 88.

Counsel for appellant conceded that the instant specification does not provide a definition for the relevant term. However, counsel submitted that the term is well-known

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in the art, and that a formal definition may be found by reference to technical dictionaries.

The McGraw-Hill Dictionary of Scientific and Technical Terms, (5th ed. 1994), at page 663, defines electronic mail as "[t]he electronic transmission of letters, messages, and memos through a communications network." The New IEEE Standard Dictionary of Electrical and Electronics Terms (5th ed. 1993), at page 426, defines electronic mail as "[t]he generation, transmission, and display of correspondence and documents by electronic means." The Microsoft Press Computer Dictionary (2nd ed. 1994), at page 143, defines electronic mail as "[t]he transmission of messages over a communications network."¹ The Microsoft Press dictionary entry for the relevant term goes on to describe ways in which electronic mail may be used, but does not restrict "electronic mail" to any particular format or protocol, nor to any particular communications network equipment.

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¹ A copy of each of the three dictionary definitions should mail as an attachment to this decision.

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We find that printer 4 receiving, analyzing, and printing a text document from a PC on the network meets all the requirements of instant claim 88.

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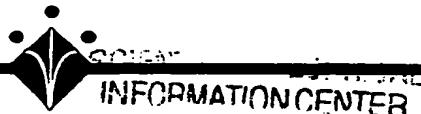
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OCT 27 1993

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230
Cho, Joe, Arthur

PUBLISHED BY
Microsoft Press
A Division of Microsoft Corporation
One Microsoft Way
Redmond, Washington 98052-6399

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transmitted in any form or by any means without the written permission of the publisher.

Library of Congress Cataloging-in-Publication Data

Microsoft Press computer dictionary : the comprehensive standard for
business, school, library, and home / Microsoft Press. -- 2nd ed.

p. cm.

ISBN 1-55615-397-2

I. Computers--Dictionaries. 2. Microcomputers--Dictionaries.

I. Microsoft Press. II. Title: Computer dictionary.

QA76.15.M54 1993

004'.03--dc20

93-29868

CIP

Printed and bound in the United States of America.

1 2 3 4 5 6 7 8 9 MLML 9 8 7 6 5 4

Distributed to the book trade in Canada by Macmillan of Canada, a division of Canada
Publishing Corporation.

Distributed to the book trade outside the United States and Canada by
Penguin Books Ltd.

Penguin Books Ltd., Harmondsworth, Middlesex, England

Penguin Books Australia Ltd., Ringwood, Victoria, Australia

Penguin Books N.Z. Ltd., 182-190 Wairau Road, Auckland 10, New Zealand

British Cataloging-in-Publication Data available.

Project Editor: Casey D. Doyle

Manuscript Editor: Alice Copp Smith

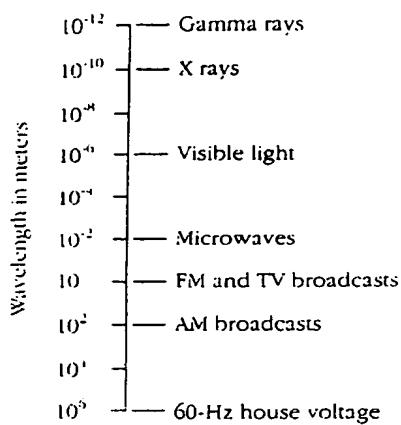
Technical Editors: Mary DeJong, Jeff Carey, Dail Magee, Jr., Jim Fuchs, Seth McEvoy



where c is the speed of light. A more convenient form of this equation is the following:

$$\text{wavelength in meters} = \frac{300}{\text{frequency in megahertz}}$$

electromagnetic spectrum The entire range of frequencies of electromagnetic radiation. In theory, there is no upper or lower limit to the electromagnetic spectrum. The spectrum is usually represented on a logarithmic scale, as shown in the illustration.



Electromagnetic spectrum.

electromotive force Commonly abbreviated EMF. Also called voltage or potential. The force that causes the movement of charge carriers in a conductor.

electron beam A stream of electrons moving in the same direction, typically in a vacuum. An electron beam in a cathode-ray tube (CRT) creates an image as it is caused to move across the phosphor coating inside the front surface of the tube. *See also CRT.*

electron gun A device that produces an electron beam, as in a television monitor or an ordinary computer monitor. *See also CRT.*

electronic bulletin board *See BBS.*

electronic circuit *See circuit.*

electronic data interchange Abbreviated EDI.

The ability to transfer information such as orders and invoices from one computer to another over a communications network. The goal of EDI is to eliminate the redundant paperwork and delays in response time inherent in mail and other delivery services. For EDI to be effective, users must agree on certain standards for formatting and exchanging information. One such standard is the X.400 protocol designed to operate on the application-layer level of the Open Systems Interconnection (OSI) network model developed by the International Organization for Standardization.

electronic data processing *See data processing.*

Electronic Industries Association *See EIA.*

electronic journal *See journal.*

electronic mail The transmission of messages over a communications network. Electronic mail, or e-mail, is a computer-to-computer (or terminal-to-terminal) version of interoffice mail or the postal service. Used on both local area networks and larger communications networks, electronic mail enables users to send and receive messages and—in some instances—graphics or voice messages, either to individual recipients or in broadcast form to larger groups. Delivered messages are stored in electronic mailboxes assigned to users on the network and can be viewed, saved, or deleted by the recipient. Depending on the capabilities of the electronic mail program, users can also forward mail, include "carbon" copies, request return receipts, attach files, and edit messages with a text editor. With systems on which the mail program can remain active in the background while the user works on other tasks, recipients can also be informed when new mail arrives and can choose to view the message immediately or save it for later viewing.

electronic music Music created with the help of computers and electronic devices. *See also MIDI, synthesizer.*

electronic office A term characteristic of the late 1970s and early to mid-1980s used in reference to the so-called computer revolution and the vision of a paperless work environment based on the

IEEE Std 100-1992

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The Institute of Electrical and Electronics Engineers, Inc.
345 East 47th Street, New York, NY 10017-2394, USA

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Printed in the United States of America

ISBN 1-55937-240-0

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January 15, 1993

SH15594

electron beams. See: electrode (electron tube.) 161-1971w

(2) (computer graphics). A device in a cathode ray tube that emits a stream of electrons that is directed by the deflection system toward the phosphor-coated screen. See also: flood gun. 610.6-1991

electron-gun density multiplication (electron tubes). The ratio of the average current density at any specified aperture through which the stream passes to the average current density at the cathode surface. 161-1971w

electronic. Of, or pertaining to, devices, circuits, or systems utilizing electron devices. Examples: Electronic control, electronic equipment, electronic instrument, and electronic circuit. See: electron device; electronics. 161-1971w

electronically de-spun antenna (communication satellite). A directional antenna, mounted to a rotating object (namely spin stabilized communication satellite), with beam switching and phasing such that the antenna beam points into the same direction in space regardless of its mechanical rotation. [24]

electronic analog computer. An automatic computing device that operates in terms of continuous variation of some physical quantities, such as electric voltages and currents, mechanical shaft rotations, or displacements, and that is used primarily to solve differential equations. Note: The equations governing the variation of the physical quantities have the same or very nearly the same form as the mathematical equations under investigation and therefore yield a solution analogous to the desired solution of the problem. Results are measured on meters, dials, oscillograph recorders, or oscilloscopes. 165-1977

electronic bulletin board. In an electronic mail system, a storage area shared by several users, each having access to all messages left in that area. 610.2-1987

electronic cash register (ECR). A device that functions as both a cash register and a point-of-sale terminal to a central computer performing inventory control, price updating, and other retail sales functions. 610.2-1987

electronic contactor (industrial control). A contactor whose function is performed by electron tubes. See: contactor. [60]

electronic controller (industrial control). An electric controller in which the major portion or all of the basic functions are performed by electron tubes. [60]

electronic counter-countermeasures (ECCM) (radar). Any electronic technique designed to make a radar less vulnerable to electronic countermeasures (ECM). 686-1982

electronic counter-countermeasures (ECCM) improvement factor (radar). The power ratio of the electronic countermeasures (ECM) signal

level required to produce a given output signal from a receiver using an ECCM technique to the ECM signal level producing the same output from the same receiver without the ECCM technique. 686-1982

electronic countermeasures (ECM) (radar). Any electronic technique designed to deny detection or accurate information to a radar. Screening with noise, confusion with false targets, and deception by affecting tracking circuits are typical types. 686-1982

electronic data processing (EDP). See: automatic data processing. 610.2-1987

electronic direct-current motor controller (industrial control). A phase-controlled rectifying system using tubes of the vapor- or gas-filled variety for power conversion to supply the armature circuit or the armature and shunt-field circuits of a direct-current motor, to provide adjustable-speed, adjustable- and regulated-speed characteristics. See: electronic controller. [60]

electronic direct-current motor drive (industrial control). The combination of an electronic direct-current motor controller with its associated motor or motors. See: electronic controller. [60]

electronic efficiency (electron tubes). The ratio of (A) the power at the desired frequency delivered by the electron stream to the circuit in an oscillator or amplifier to (B) the average power supplied to the stream. 161-1971w

electronic funds transfer system (EFTS). A data collection and telecommunication system that electronically transports information about the movement of funds between accounts managed by financial institutions. 610.2-1987

electronic keying. A method of keying whereby the control is accomplished solely by electronic means. See: telegraphy. 145-1983

electronic line scanning (facsimile). That method of scanning that provides motion of the scanning spot along the scanning line by electronic means. See: scanning. 168-1956w

electronic mail. (A) The generation, transmission, and display of correspondence and documents by electronic means. See also: electronic bulletin board; electronic mailbox. Syn: mailbox service. (B) The concepts and technologies employed for the electronic communication of textual material. 610.2-1987

electronic mailbox. A storage area used to hold all messages addressed to a particular user of an electronic mail system. 610.2-1987

electronic microphone. A microphone that depends for its operation on a change in the terminal electrical characteristic of an active device when a force is applied to some part of the device. See: microphone. [32]

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Fifth Edition

Sybil P. Parker

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(Dennis Kunkel, University of Hawaii)

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McGRAW-HILL DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS,

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6 7 8 9 0 DOW/DOW 03 02 01 00

ISBN 0-07-042333-4

Library of Congress Cataloging-in-Publication Data

McGraw-Hill dictionary of scientific and technical terms /
Sybil P. Parker, editor in chief...—5th ed.

p. cm.

ISBN 0-07-042333-4

1. Science—Dictionaries. 2. Technology—Dictionaries.

I. Parker, Sybil P.

Q123.M34 1993

503—dc20

93-34772

CIP

INTERNATIONAL EDITION

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electronic mail

electronic magnetic moment. [i,lek'trā-nik mag'ned-ik 'mō̄-mənt]

electronic mail [COMMUN] The electronic transmission of news, messages, and memos through a communications network. [i,lek'trā-nik 'māl̄]

electronic microradiography [ELECTR] Microradiography of very thin specimens in which the emission of electrons from an irradiated object, either the specimen or a lead screen behind it, is used to produce a photographic image of the specimen, which is then enlarged. [i,lek'trā-nik 'mī-kō̄rād'ig-rāfē]

electronic motor control [ELECTR] A control circuit used to control the speed of a direct-current motor operated from an alternating-current power line. Also known as direct-current motor control. [i,lek'trā-nik 'mō̄d-ōr kō̄n, trō̄l̄]

electronic multimeter [ELECTR] A multimeter that uses semiconductor or electron-tube circuits to drive a conventional scale meter. [i,lek'trā-nik 'mālt̄-ē,mēd̄-ōr]

electronic music [ENG ACOUS] Music consisting of tones resulting in electronic sound and noise generators used alone or in conjunction with electroacoustic shaping means and sound-producing equipment. [i,lek'trā-nik 'myū-zik̄]

electronic musical instrument [ENG ACOUS] A musical instrument in which an audio signal is produced by pickup or oscillator and amplified electronically to feed a loudspeaker, as in an electric guitar, electronic carillon, electronic organ, or electronic piano. [i,lek'trā-nik 'myū-zik̄ 'instrō̄-mēnt̄]

electronic navigation [NAV] Navigation by means of any electronic device or instrument. [i,lek'trā-nik 'nāvō̄gā-shān]

electronic noise jammer [ELECTR] An electronic jammer that emits a radio-frequency carrier modulated with a white noise signal usually derived from a gas tube; used against enemy aircraft. [i,lek'trā-nik 'nō̄iz 'jam̄-ər]

electronic Numerical Integrator and Calculator See ENIAC. [i,lek'trā-nik nū̄mer-ik̄ 'int̄grāt̄-ōr, grād̄-ōr ən 'kāl̄-kyō̄, läd̄-ōr]

electronic organ [ELECTR] A musical instrument which uses electronic circuits to produce music similar to that of a pipe organ. [i,lek'trā-nik 'ōrgān]

electronic packaging [ENG] The technology of packaging electronic equipment; in current usage it refers to inserting discrete components, integrated circuits, and MSI and LSI chips usually attached to a lead frame by beam leads into plates through holes on multilayer circuit boards (also called cards); then they are soldered in place. [i,lek'trā-nik 'pāk-ijēḡ]

electronic phase-angle meter [ELECTR] A phasemeter that makes use of electronic devices, such as amplifiers and limiters, to convert the alternating-current voltages being measured to sine waves whose spacings are proportional to phase. [i,lek'trā-nik 'fāz̄ ,ānggō̄l̄, mēd̄-ōr]

electronic photometer See photoelectric photometer. [i,lek'trā-nik 'fō̄tō-mēt̄-ōr]

electronic piano [ELECTR] A piano without a sounding board, in which vibrations of each string affect the capacitance of a capacitor microphone and thereby produce audio-frequency signals that are amplified and reproduced by a loudspeaker. [i,lek'trā-nik pā'nō̄]

electronic polarization [ELEC] Polarization arising from the movement of electrons with respect to the nuclei with which they are associated, upon application of an external electric field. [i,lek'trā-nik pō̄lārāz̄-āshān]

electronic position indicator [NAV] A radio navigation system used in hydrographic surveying which provides circular cues of position. Abbreviated EPI. [i,lek'trā-nik pā̄z̄ishn̄-ōr]

electronic power supply See power supply. [i,lek'trā-nik pō̄w̄s̄pl̄-ē]

electronic publishing [COMMUN] The provision of information with high editorial and value-added content in electronic form, allowing the user some degree of control and interactivity. [i,lek'trā-nik 'pōbl̄ish̄-ēḡ]

electronic pumping See pumping. [i,lek'trā-nik 'pāmp̄-ēḡ]

electronic radiography [ELECTR] Radiography in which the image is detected by direct image converter tubes or by the use of television pickup or electronic scanning, and the resultant signals are amplified and presented for viewing on a kinescope. [i,lek'trā-nik rād̄-ēḡ-āfr̄f̄]

electronic raster scanning See electronic scanning. [i,lek'trā-nik 'rāst̄-ēskān̄-ēḡ]

electronic reconnaissance [ELECTR] The detection, identification, evaluation, and location of foreign, electromagnetic radiations emanating from other than nuclear detonations or radioactive sources. [i,lek'trā-nik ri'kān̄-ēsāns]

electronic recording [ELECTR] The process of making a graphical record of a varying quantity or signal (or the result of such a process) by electronic means, involving control of an electron beam by electric or magnetic fields, as in a cathode-ray oscilloscope, in contrast to light-beam recording. [i,lek'trā-nik ri'kōrd̄-ēḡ]

electronic robot [CONT SYS] A robot whose motions are powered by a direct-current stepper motor. [i,lek'trā-nik 'rō̄, bāt̄]

electronics [PHYS] Study, control, and application of the conduction of electricity through gases or vacuum or through semiconducting or conducting materials. [i,lek'trā-niks]

electronic scanning [ELECTR] Scanning in which an electron beam, controlled by electric or magnetic fields, is swept over the area under examination, in contrast to mechanical or electromechanical scanning. Also known as electronic raster scanning. [i,lek'trā-nik 'skān̄-ēḡ]

electronic sculpturing [COMPUT SCI] Procedure for constructing a model of a system by using an analog computer, in which the model is devised at the console by interconnecting components on the basis of analogous configuration with real system elements; then, by adjusting circuit gains and reference voltages, dynamic behavior can be generated that corresponds to the desired response, or is recognizable in the real system. [i,lek'trā-nik 'skālp-chārt̄-ēḡ]

electronic security [ELECTR] Protection resulting from all measures designed to deny to unauthorized persons information of value which might be derived from the possession and study of electromagnetic radiations. [i,lek'trā-nik sō̄'kyū-rād̄ē]

electronic sky screen equipment [ELECTR] Electronic device that indicates the departure of a missile from a predetermined trajectory. [i,lek'trā-nik 'skī, skrēn ī,kwip̄mēnt̄]

electronic specific heat [SOLID STATE] Contribution to the specific heat of a metal from the motion of conduction electrons. [i,lek'trā-nik sp̄sif̄ik 'hēt̄]

electronic spectrum [SPECT] Spectrum resulting from emission or absorption of electromagnetic radiation during changes in the electron configuration of atoms, ions, or molecules, as opposed to vibrational, rotational, fine-structure, or hyperfine spectra. [i,lek'trā-nik 'spek-trām̄]

electronic speedometer [ENG] A speedometer in which a transducer sends speed and distance pulses over wires to the speed and mileage indicators, eliminating the need for a mechanical link involving a flexible shaft. [i,lek'trā-nik sp̄d̄-ādm̄-ēr̄]

electronic spreadsheet [COMPUT SCI] A type of computer software for performing mathematical computations on numbers arranged in rows and columns, in which the numbers can depend on the values in other rows and columns, allowing large numbers of calculations to be carried out simultaneously. [i,lek'trā-nik 'sp̄red,shēt̄]

electronic state [QUANT MECH] The physical state of electrons of a system, as specified, for example, by a Schrödinger-Pauli wave function of the positions and spin orientations of all the electrons. [i,lek'trā-nik 'stāt̄]

electronic structure [PHYS] The arrangement of electrons in an atom, molecule, or solid, specified by their wave functions, energy levels, or quantum numbers. [i,lek'trā-nik 'strō̄k̄-chār̄]

electronic support measures See electronic warfare support measures. [i,lek'trā-nik sō̄'pō̄t̄, mez̄-är̄z̄]

electronic surge arrester [ELECTR] Device used to switch to ground high-energy surges, thereby reducing transient energy to a level safe for secondary protectors, for example, Zener diodes, silicon rectifiers and so on. [i,lek'trā-nik 'sō̄r̄ ē, res̄t̄-ēr̄]

electronic switch [ELECTR] 1. Vacuum tube, crystal diodes, or transistors used as an on and off switching device. 2. Test instrument used to present two wave shapes on a single gun cathode-ray tube. [i,lek'trā-nik 'swich̄]

electronic switching [COMMUN] Telephone switching using a computer with a storage containing program switching logic, whose output actuates reed switches that set up telephone connections automatically. [ELECTR] The use of electronic circuits to perform the functions of a high-speed switch. [i,lek'trā-nik 'swich̄-ēḡ]

electronic tablet [COMPUT SCI] A data-entry device consisting of stylus, writing surface, and circuitry that produces a pair

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte TETSURO MOTOYAMA

DEC 30 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-0544
Application No. 08/883,492

5244-054-2X

HEARD: October 21, 2003

Before BARRETT, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

RECEIVED: 12/18/03
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.

DOCKETING DEPT

Initials/Date Docketed: PP 12/31/03
Type of Resp(s) Appeal to CAFC Req Rehearing / File
Due Date(s): 12-29-04 (n-E) and

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4, 6-16, 18-20, 22-25, 27-37, 39-41, and 43-46, which are all the claims remaining in the application.

We affirm-in-part, and enter new grounds of rejection in accordance with 37 CFR § 1.196(b).

BACKGROUND

The invention is directed to a method and system for transmission and reception of electronic mail messages between a monitoring device and a device monitored by the monitoring device. Representative claims 1 and 18 are reproduced below.

1. A method of controlling communications, comprising the steps of:
 - automatically generating, by a first monitoring device, a first message which comprises an Internet electronic mail message;
 - automatically transmitting, from the first monitoring device, the first message to a second monitored device;
 - monitoring, by the first monitoring device, whether the second monitored device transmits, to the first monitoring device, a response to the first message; and
 - transmitting, by the first monitoring device, a second message to the second monitored device when the step of monitoring determines that the first monitoring device has not received a response to the Internet electronic mail message from the second monitored device,

wherein the second monitored device comprises a monitored business office device.
18. A method of controlling communications, comprising the steps of:
 - automatically generating, by a first monitoring device, a first message which comprises an Internet electronic mail message;
 - automatically transmitting, from the first monitoring device, the first message to a second monitored device;
 - receiving, by the second monitored device, the Internet electronic mail message;
 - processing the Internet electronic mail message by the second monitored device; and

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transmitting from the second monitored device to the first monitoring device a second message which includes status information of an operator contained within the first message,

wherein the second monitored device comprises a monitored business office device.

The examiner relies on the following references:

Williams et al. (Williams)	5,424,724	Jun. 13, 1995
Witek	5,461,488	Oct. 24, 1995 (filed Sep. 12, 1994)
Kraslavsky et al. (Kraslavsky)	5,537,626	Jul. 16, 1996 (filed Feb. 13, 1995)
Homma et al. (Homma)	5,572,678	Nov. 5, 1996 (filed Jan. 25, 1993)
Naugle	5,715,393	Feb. 3, 1998 (filed Jun. 21, 1995)

Claims 1 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Naugle, Witek, and Williams.

Claims 2-4 and 6-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Naugle, Witek, Williams, and Homma.

Claims 10-16, 19, 20, 22-25, 27-37, 39-41, and 43-46 stand rejected under 35 U.S.C. § 103 as being unpatentable over Naugle, Witek, Williams, Homma, and Kraslavsky.

We refer to the Final Rejection (Paper No. 23) and the Examiner's Answer (Paper No. 26) for a statement of the examiner's position and to the Brief (Paper No.

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25) and the Reply Brief (Paper No. 27) for appellant's position with respect to the claims which stand rejected.

OPINION

Grouping of claims

Appellant nominally groups claims together (Brief at 5), apparently without regard to the three different rejections applied against the claims. The claims with respect to each ground of rejection could be held to stand or fall together. See In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim."). However, we will consider all of appellant's arguments presented in the Brief as we review each ground of rejection.

For future reference, appellant should note that the brief should address each rejection under a separate heading, and that "grouping of claims" is with respect to a particular ground of rejection.

[37 CFR] § 1.192 Appellant's brief.

....

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner.

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Application No. 08/883,492

.....
(6) Issues. A concise statement of the issues presented for review.

(7) Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) Argument. The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

.....
Section 103 rejection of claims 1 and 18 over Naugle, Witek, and Williams

The rejection of claims 1 and 18 is set forth at pages 4 and 5 of the Answer. As appellant observes, the rejection appears to rely on Witek and Williams for features that are not required by instant claim 18. We enter new grounds of rejection against claim 18, infra.

In any event, appellant advances two arguments in support of claim 18 (Brief at 8-9), neither of which we find persuasive. First, appellant points out that claim 18 requires that the second monitored device comprises a "monitored business office

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device." We do not consider the language to distinguish over the teachings of Naugle. (See statement of new grounds of rejection, *infra*.) Second, appellant argues that Naugle, Witek, and Williams cannot be combined, for the reasons presented at pages 5 through 8 of the Brief, nominally in support of claims 1, 22, and 43. Neither do we find that argument persuasive, for the same reasons that we are not persuaded of patentability of claims 22 and 43. (See *infra*, "Section 103 rejection of claims 10-16, 19, 20, 22-25, 27-37, 39-41, and 43-46 over Naugle, Witek, Williams, Homma, and Kraslavsky.") We thus sustain the Section 103 rejection of claim 18.

With respect to the rejection of claim 1, appellant argues (Brief at 8) that, even if Naugle and Williams were to be combined as contemplated by the rejection, the relevant features of the claimed invention would not result. Appellant points out that claim 1 requires that the first and second messages be transmitted to the same (second monitored) device. The examiner relies on Williams' disclosure, Figure 3, step 94, and the discussion at column 5, lines 27 through 54 for the relevant teaching. (Answer at 5.) However, consistent with appellant's arguments, the material at column 5 and Figure 3 of Williams reveals that the message is sent to the "next listed default host agent" -- from the "ordered list **58** of host agents" shown in Figure 2 -- rather than to the same device to which the earlier message was transmitted. We find no satisfactory

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response to appellant's argument in the Answer.¹ We do not sustain the rejection of claim 1.

Section 103 rejection of claims 2-4 and 6-9 over Naugle, Witek, Williams, and Homma

We have not sustained the Section 103 rejection of base claim 1. Since the rejection applied against claims 2-4 and 6-9 does not remedy the deficiency of the rejection applied against claim 1, neither do we sustain the rejection of claims 2-4 and 6-9.

Section 103 rejection of claims 10-16, 19, 20, 22-25, 27-37, 39-41, and 43-46 over Naugle, Witek, Williams, Homma, and Kraslavsky

We do not sustain the Section 103 rejection of claims 10-16, because the rejection does not remedy the deficiency in that applied against base claim 1.

Appellant nominally groups claims 1, 22 and 43 together (Brief at 5-8). As noted above, we find the arguments presented with respect to claim 1 to be persuasive. However, the arguments presented with regard to transmitting first and second messages to the same device (Brief at 8) are not commensurate with the scope of

¹ Perhaps the rejection is based on the electronic mail being transmitted, and retransmitted, to the same destination node; i.e., the same ultimate recipient. However, the iterative process described by Williams is performed by a "host agent server," rather than by the source of the original mail message. See, e.g., col. 5, ll. 41-54.

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claims 22 and 43. In particular, the claims do not require that the second message be sent to the same device.

Appellant's additional arguments in support of claims 22 and 43 are directed to an allegedly unfounded combination of teachings with respect to Naugle, Witek, and Williams. We note, however, that the rejection relies on Witek to show transmission of messages to a "business office device." We consider the teachings of Witek to be merely cumulative, because we find that Naugle discloses a "business office device" within the meaning of the claims. (See new grounds of rejection, infra.)

Appellant further argues (Brief at 7-8) that Naugle and Williams cannot be combined, because there is not a problem or issue in Naugle of knowing what host agent to use. However, we do not think it necessary that Naugle recognize or teach that particular problem. The teachings of Williams are directed to distributing electronic mail documents in a data processing system "having multiple systems and external networks." Col. 1, ll. 1-19. The artisan thus would have found the combined teachings to suggest transmission of messages beyond the local network described by Naugle, with Williams teaching refinements in the management of transmission of the messages.

Appellant's arguments in support of claims 23 and 44 appear at pages 9 and 10 of the Brief. Appellant argues that the teachings of Homma would not have been seen as applicable to the system of Naugle because "[a]t the time of this invention, e-mail

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was not very good at transmitting large amounts of data and not utilized to transmit large amounts of data."

Appellant does not define what should be considered a "large" amount of data. In any event, appellant does not point to anything in the references in support of the position. Further, appellant has not provided evidence in support of the assertion. We thus find the argument untenable.

Appellant makes one further observation relevant to the rejection applied against claims 22 and 43, which does not appear to be in the form of an argument. Appellant observes that the system of Naugle utilizes the "connection list process for multicast transmission, as illustrated in Figure 3A" of Homma. (Brief at 10.) While that may be true, Homma is the reference relied upon as teaching connection-mode messages (Figure 3B) as a back-up system having reliability greater than that inherent in the system shown in Figure 3A.

Finally, we note appellant's arguments in support of claim 39 (Brief at 9), nominally grouped with claim 18, but find them unpersuasive for the same reasons that we have set forth supra with respect to claim 18.

We have considered all of appellant's arguments in support of the subject matter of claims 10-16, 19, 20, 22-25, 27-37, 39-41, and 43-46. We sustain the Section 103 rejection of claims 19, 20, 22-25, 27-37, 39-41, and 43-46. We do not sustain the rejection of claims 10-16 due to their incorporation of the limitations of base claim 1.

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Application No. 08/883,492

New Grounds of Rejection -- 37 CFR § 1.196(b)

We enter the following new grounds of rejection against the claims in accordance with 37 CFR § 1.196(b): Claims 18, 19, 20, and 39-41 are rejected under 35 U.S.C. § 102(e)(2) as being anticipated by Naugle. Claims 1, 22, and 43 are rejected under 35 U.S.C. § 103 as being unpatentable over Naugle.

Naugle describes a method of controlling communications comprising automatically generating, by a first monitoring device (monitor computer 11, Fig. 2), a first message which comprises an Internet electronic mail message.

As described in column 2 of the reference, in Naugle's system the computers are connected in a network 37 (Fig. 1) using TCP/IP network protocol. At a predetermined time, monitor computer 11 sends a network verify command to a target computer 12 (Fig. 2). Next, a test of the email capability of the target computer is performed to ensure that email service in the target computer is operational. Col. 3, ll. 7-10. Naugle describes using the "Sendmail" software package, which is standard in the "Unix-like" operating systems of the respective computers. Id. at ll. 21-30. Although Naugle does not expressly disclose sending the electronic mail message over the Internet, we note that instant claim 18 does not require sending the "Internet electronic mail message" over the Internet. Consistent with our understanding of electronic mail formats of "Unix-like" systems, appellant in the briefs does not argue that Naugle fails to disclose an "Internet electronic mail message" within the meaning of the claims.

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Naugle further describes that, after the monitoring device (monitor computer 11) receives an email reply message from the monitored device (target computer 12), the monitor computer automatically generates and transmits an email message to the target computer. The target computer receives and processes the email message. The target computer transmits to the monitor computer a message which includes "status information of an operator" contained in the message sent from the monitor to the target, in the terms of claim 18. The monitor computer sends a message requesting status information (col. 4, ll. 9-35), and the target computer transmits to the monitor computer a message containing the requested status information (col. 5, ll. 22-26).

Instant claim 18 concludes, "wherein the second monitored device comprises a monitored business office device." Naugle discloses that the computers may be used for business-related applications (col. 2, ll. 47-52), and thus may reside in business offices. On this record, we do not see how the claimed "business office device" might be thought to distinguish over the monitored computer disclosed by Naugle.

We thus find that instant claim 18 is anticipated under 35 U.S.C. § 102 by Naugle. With respect to claim 19, return of the status message from the target computer (bottom of columns 3 and 4 of Naugle) is an indication that an operator has finished executing (i.e., status information has been gathered), thus meeting the terms of the claim. We also find claim 20 to be anticipated, because the monitor computer of Naugle is networked with the target computer, and is thus also a "business office device."

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Instant claims 39, 40, and 41 are "system" versions of claims 18, 19, and 20, which we also find to be anticipated by Naugle.

With respect to our rejection of claims 1, 22, and 43 under 35 U.S.C. § 103 as being unpatentable over Naugle, we refer to our findings, supra, with regard to instant claim 18 in view of Naugle. Instant claim 1 further requires monitoring, by the first monitoring device, whether the second monitored device transmits a response to the first message from the monitoring device. Claim 1 additionally requires the step of transmitting a second message to the monitored device when the monitoring device determines that it has not received a response to the Internet electronic mail message from the monitored device.

Naugle teaches the importance of testing email between the monitor computer 11 and the target computer 12, to ensure that multiple messages are not sent to a disabled (target) computer. Naugle teaches avoiding a large number of queued messages that can cause network congestion, delaying or inhibiting restart of target computer 12. Thus, if email is determined to be not operational, monitor computer 11 sends no more messages, but takes corrective action such as notifying an operator. Col. 3, l. 30 - col. 4, l. 4.

Naugle does not disclose how many messages may be sent from the monitor computer to a target computer before the determination is made that the computer (or its email subsystem) is disabled. Naugle expressly teaches against sending a volume of messages sufficient to cause network congestion. However, instant claim 1 requires

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but a second message to be sent, when the monitoring device determines there has been no response to a first message. In light of Naugle's teachings, the artisan would have found it obvious to send at least a second message, after not receiving response to the first, before making a determination that the target computer is disabled; i.e., that a lack of response is due to more than a transient problem with the network or with the target computer.² A first and a second message would be well outside of the volume of messages that Naugle warns against.

Instant claim 22 is a "system" version of claim 1, and claim 43 is a "computer program product" version of the same, that we conclude would have been obvious for substantially the same reasons as those set forth with respect to claim 1.

CONCLUSION

The rejection of claims 18-20, 22-25, 27-37, 39-41, and 43-46 under 35 U.S.C. § 103 is affirmed, but the rejection of claims 1-4 and 6-16 is reversed. The examiner's rejection of claims 1-4, 6-16, 18-20, 22-25, 27-37, 39-41, and 43-46 is thus affirmed-in-part.

Claims 1, 18-20, 22, 39-41, and 43 are newly rejected by us under 35 U.S.C. § 102 or 103.

² Although Naugle does not describe in detail the "Sendmail" system that is used, we note that email programs conventionally make a predetermined number of attempts at transferring a message, before reporting to the sender that transfer of the message cannot be completed.

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Application No. 08/883,492

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b).

37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claim:

- (1) Submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner . . .
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 2003-0544
Application No. 08/883,492

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART -- 37 CFR 1.196(b)


LEE E. BARRETT
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

Appeal No. 2003-0544
Application No. 08/883,492

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA , VA 22314



The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

OCT 25 2004

5244-0084-2X

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Technology Center 2100

RECEIVED: *62404*
OLSON, SPEAK, McCLELLAND
MAIER & NEUSTADT, P.C.

DOCKETING DEPT.

Initials/Date Docketed: *Wm2504*

Type of Resp(s): _____

Due Date(s): _____

Ex parte TETSURO MOTOYAMA

Appeal No. 2004-1205

Application 09/192,583

MAILED

JUN 18 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ORDER DISMISSING APPEAL

Before HARKCOM, Acting Chief Administrative Patent Judge, WILLIAM F. SMITH,
Administrative Patent Judge, and JEFFREY V. NASE, Administrative Patent Judge.

Per curiam.

On May 24, 2004, counsel for the appellant filed a Request for Continued Examination (RCE) under 37 CFR § 1.114 (Paper No. 32). Pursuant to the notice entitled "Request for Continued Examination Practice and Changes to Provisional Application Practice," 65 Fed. Reg. 50092, 50095 (Aug. 16, 2000), and the provisions of 37 CFR § 1.114(d), a request for continued examination under 37 CFR § 1.114 filed after appeal has been taken, but prior to a decision on the appeal, "will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner."

**Appeal No. 2004-1205
Application 09/192,583**

Accordingly, the appeal in this application is dismissed.

The application is being returned to the examiner for further action as may be appropriate.

**GARY V. HARKCOM, Acting Chief
Administrative Patent Judge**

WILLIAM F. SMITH
Administrative Patent Judge

□ 13

W. H. G. - J. C. G.

JEFFREY V. NASE
Administrative Patent Judge

GVH:tdl

Appeal No. 2004-1205
Application No. 09/192,583

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 30 2003

OCT 25 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Technology Center 2100

Ex parte TETSURO MOTOYAMA and MASAICHI NIRO

Appeal No. 2002-2316
Application No. 09/408,443

5244-0093-2

HEARD: April 16, 2003

Before JERRY SMITH, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16-35, which are all the claims remaining in the application.

We reverse.

RECEIVED: 5-2-03
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: WS:2B.
Type of Resp(s): _____
Due Date(s): _____

BACKGROUND

The invention is directed to a method and system for processing communications between a device on a network and computers local to, and remote from, the network device. The communications include information obtained from sensors of the network device. Claim 16 is reproduced below.

16. A method of processing messages, comprising the steps of:

transmitting a message from a network device to a first computer which is remote from said network device, said message including information obtained from sensors of the network device;

receiving the message by the first computer;

determining, by the first computer, if a communication containing at least part of the message including at least some of the information obtained from sensors is to be transmitted from the first computer to a second computer which is local to said device;

transmitting the communication from the first computer to the second computer in response to the determination made by the first computer; and

receiving said communication by the second computer.

The examiner relies on the following references:

Tarr et al. (Tarr)	5,184,179	Feb. 2, 1993
Aikens et al. (Aikens)	5,414,494	May 9, 1995
Frantz	6,003,070	Dec. 14, 1999 (filed Feb. 25, 1997)

Claims 16 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Aikens and Tarr.

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Application No. 09/408,443

Claims 18-35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Aikens, Tarr, and Frantz.

We refer to the Final Rejection (Paper No. 15) and the Examiner's Answer (Paper No. 20) for a statement of the examiner's position and to the Brief (Paper No. 19) and the Reply Brief (Paper No. 21) for appellants' position with respect to the claims which stand rejected.

OPINION

In the rejection set forth at pages 4 and 5 of the Answer, the examiner contends, in essence, that Aikens discloses the first two steps required by instant claim 16. The rejection turns to Tarr for suggestion of that deemed to be missing from Aikens.

Appellants assert (Brief at 5-6) that nothing in Tarr would have suggested the details of the "determining" and "transmitting" steps of claim 16. The examiner responds (Answer at 8-9) that Tarr teaches that if a first, remote computer has not received a signal within a given period of time from second, local computers, then the first computer automatically transmits a message containing at least some information obtained from the sensors on the local network. Appellants respond in turn (Reply Brief at 1-3) that although Tarr discloses sending a signal from a remote computer to local network systems for triggering information to be sent to the remote computer, claim 16 requires more.

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Application No. 09/408,443

We have studied the references applied against instant claim 16, with particular emphasis on the sections of Tarr pointed out by the examiner where the alleged teachings are deemed to reside. We agree with appellants that no proper combination of the references would have suggested the claimed subject matter.

Tarr discloses several embodiments (e.g., Figs. 1-4) directed to local monitoring of diagnostic, maintenance, or billing information that may be sent to a remote computer. Information may be transmitted at predetermined times that are under local control (e.g., col. 5, ll. 14-22). A remote computer may also poll a local system for the required information, as when a local system has not transmitted its information at the predesignated time (e.g., col. 10, ll. 19-38).

Claim 16 requires, however, that the first, remote computer receives a message including information stored from sensors of a network device and determines if information obtained from the sensors is to be transmitted to the second, local computer. If indicated, a communication containing information from the local sensors is transmitted from the remote computer to the local computer. We find no suggestion in the references before us for the processing and transfer of information as required by the claim. We thus do not sustain the rejection of claim 16.

Claim 26, the only other independent claim on appeal, is in the form of a means plus function version of claim 16. Although Frantz is added to the combination of Aikens and Tarr in the rejection of claim 26, the Frantz reference is apparently relied upon for its teachings relating to electronic or Internet mail messages. Because Frantz

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Application No. 09/408,443**

fails to remedy the deficiencies of Aikens and Tarr, we do not sustain the rejection of claim 26.

Because the relied-upon references fail to show prima facie obviousness of either of the independent claims on appeal, we do not sustain the section 103 rejections of claims 16-35.

Appeal No. 2002-2316
Application No. 09/408,443

CONCLUSION

The rejection of claims 16-35 under 35 U.S.C. § 103 is reversed.

REVERSED



JERRY SMITH
Administrative Patent Judge

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) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES


STUART S. LEVY
Administrative Patent Judge

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HOWARD B. BLANKENSHIP
Administrative Patent Judge

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**Appeal No. 2002-2316
Application No. 09/408,443**

**OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA , VA 22314**

NOTICE

**Board of Patent Appeals and Interferences Mail
Effective May 1, 2003**

Appeals

All correspondence in an application involved in an appeal to the Board of Patent Appeals and Interferences during the period from when an appeal docketing notice is issued until a decision has been rendered by the Board of Patent Appeals and Interferences as well as any hearing confirmations, waivers and requests for rehearing of a decision by the Board of Patent Appeals and Interferences should be mailed to:

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